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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,605	01/29/2004	Mark J. Rupar	MECO:017--3 11792.0017.DV	6248

7590 08/04/2005

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EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
1638	

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/767,605

Applicant(s)

RUPAR ET AL.

Examiner

Anne R. Kubelik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 57 is/are allowed.
- 6) ☒ Claim(s) 59-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: sequence search results.

DETAILED ACTION

1. Claims 57 and 59-62 are pending.
2. The sequence listing is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure relative to the sequence listing of parent application 08/721,259. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material that is not supported by the original disclosure is as follows: Amino acid 129 of SEQ ID NO:2 in 08/721,259, now US Patent 6,093,695, is an Arg, while amino acid 129 of SEQ ID NO:2 in the instant application is an Ala (see sequence search results). As the instant application is a divisional of 08/721,259 and its child applications, not a CIP, this change constitutes new matter.

It is noted that Application 09/611,216, now US Patent 6,537,756, filed 6 July 2000, which is a divisional of 08/721,259, has the same sequence as 08/721,259, Application 10/386,972, now US Patent 6,686,452, filed 12 March 2003, which is a divisional of 09/611,216, has the same sequence as the instant application.

It is also noted that the sequence in Figure 1B in the instant case and 10/386,972 has Ala at amino acid 129.

Applicant is required to cancel the new matter, correct the sequence listing and computer readable form, or correct their priority claim in the reply to this Office Action.

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-

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filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). As discussed above, the disclosure of the instant application introduces new matter relative to parent applications 09/611,216 and 08/721,259, and thus cannot be a divisional.

4. The title of the invention is not descriptive of the instant invention. A new title is required that is clearly indicative of the invention to which the claims are directed. Note that titles can be up to 500 characters long.

5. The abstract is not descriptive of the instant invention, which are plants transformed with a nucleic acid encoding as CryET29 endotoxin. A new abstract is required that is clearly indicative of the invention to which the claims are directed. The abstract of the disclosure should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 59-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Dependent claims are included in all rejections.

Claim 59 should be drawn to a single cell. It is unclear if a single cell would be encompassed by the claim as currently written.

It is unclear in claim 60 if the progeny comprise the functional genetic element.

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It is unclear in claim 61 if the seeds comprise the functional genetic element.

Claim 61 should be drawn to a single seed. It is unclear if a single seed would be encompassed by the claim as currently written.

It is unclear in claim 62 where the promoter and the 3' region are located relative to the promoter and 3' region of the gene that encodes a CryET29 protein, as genes have 5' and 3' regulatory regions.

8. Claims 57 and 59-62 are free of the prior art, given the failure of the prior to teach or suggest an isolated nucleic acid encoding SEQ ID NO:2. Using the filing date of Application 09/611,216, in which the Arg¹²⁹ to Ala¹²⁹ substitution first appeared, 6 July 2000, the closest prior art is the nucleic acid encoding the CryET29 sequence published in Rupar et al (1998, WO 98/13497), which differs from SEQ ID NO:2 at said amino acid 129. The next closest prior art is a nucleic acid taught by Koni et al (1993, J. Mol. Biol. 229:319-327); this nucleic acid encodes a protein with 56.0% identity to SEQ ID NO:2.

9. Claim 57 is allowable.

10. Claims 59-62 are would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (571) 272-0804. The central fax number for official correspondence is (571) 273-8300.

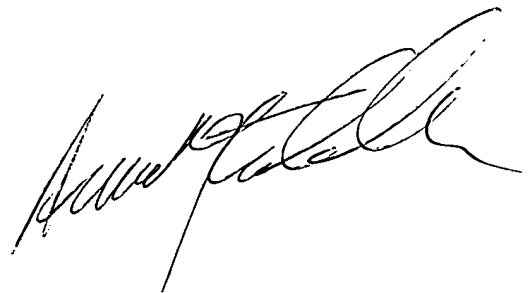
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne R. Kubelik, Ph.D.
July 6, 2005



**ANNE KUBELIK, PH.D.
PRIMARY EXAMINER**



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